

DEC 12 2006

Application No. 10/791,916
Amendment dated December 12, 2006
Reply to Final Office Action of September 12, 2006

REMARKS

Claims Summary

Claims 1-51, 53-69, 71 and 72 are pending. Of these, claims 8-10, 27-31, 39, 41-45, 55-59, 68 and 69 have been withdrawn from consideration. Claims 52 and 70 are canceled.

Reconsideration of the application in view of the current claims is respectfully requested and further in view of the following remarks.

Interview

Applicant would like to thank the Examiner for the telephonic interview conducted on December 12, 2006, with the undersigned attorney during which possible amendments to the claims were discussed. Applicant encourages the Examiner to call the undersigned attorney for any further discussion of claim language that could help place the claims in condition for allowance.

Rejection of Claims 1-7, 11-15, 33-36, 38, 40, 46, 53, 54 and 57 over Mazzocchi

The Examiner rejected claims 1-7, 11-15, 33-36, 38, 40, 46, 53, 54 and 57 under 35 U.S.C. § 102(b) as being anticipated by Mazzocchi US Patent No. 6,506,204 ("Mazzocchi"). Without conceding the point, Applicant have amended independent claims 1, 33 and 53 to more specifically recite the inflatable aspects of their invention. As amended, claims 1, 33 and 53, and the claims depending from them, are patentable over Mazzocchi under § 102(b). Applicant reserves the right to pursue the original subject matter of these claims in a continuation application.

Rejection of Claims 1-3, 5-7, 15-26, 32, 53, 54, 60 and 61 over Van Tassel

The Examiner rejected claims 1-3, 5-7, 15-26, 32, 53, 54, 60 and 61 under 35 U.S.C. § 102(e) as being anticipated by Van Tassel et al. U.S. Patent No. 6,652,555 ("Van Tassel").

Applicant respectfully traverses the rejection as Van Tassel does not disclose every limitation of the present claims.

Independent claim 1, as amended, recites the limitation of an "inflatable partitioning element which has an outer periphery configured to engage surfaces of a ventricular chamber of

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the patient's heart to partition the chamber into a main productive and a secondary, non-productive portion, the inflatable partitioning element comprising a hollow interior adapted to contain an inflation fluid and an inflation port communicating with the hollow interior." Van Tassel, on the other hand, places a balloon into an atrial appendage, and his device lacks the recited inflatable partitioning element. Furthermore, Van Tassel is silent on how to partition the much larger volume of the ventricle and how to retain the partition in place against the pressure of the heart cycle. The anchor elements of Van Tassel require pressing against the constricted neck (ostium) of the atrial appendage, or bracing against or pinching tissue outside of the ventricle (i.e. the atrial appendage). See Van Tassel, Figure 18. A device configured to fit within an atrial appendage is not configured to partition a ventricle.

In addition, claim 1 recites an anchoring element configured to secure the inflatable element within the ventricle. Van Tassel discloses no such element. Van Tassel therefore does not anticipate claim 1.

Claim 21 recites a device with an inflatable partitioning element configured to partition a ventricular chamber into productive and non-productive portions. Once again, Van Tassel's device is configured to fit within an atrial appendage and is not configured to partition a ventricle.

In addition, claim 21 recites a distally extending supporting element configured to engage a region of the non-productive portion of the ventricular chamber. Van Tassel has no such element. Van Tassel therefore does not anticipate claim 21.

Claim 53 recites a device with an inflatable partitioning means configured to partition a ventricular chamber into productive and non-productive portions. Once again, Van Tassel's device is configured to fit within an atrial appendage and is not configured to partition a ventricle.

In addition, claim 53 recites a distally extending supporting means configured to engage a region of the non-productive portion of the ventricular chamber. Van Tassel has no such element. Van Tassel therefore does not anticipate claim 53.

Based on the foregoing, Applicant respectfully requests withdrawal of the rejection of claims 1-3, 5-7, 15-26, 32, 53, 54, 60 and 61 over Van Tassel under 35 U.S.C. § 102(b).

DEC 12 2006

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Rejection of Claims 21 and 37 over Mazzocchi and Lichtenstein

The Examiner rejected Claims 21 and 37 under 35 U.S.C. § 103(a) as being unpatentable over Mazzocchi in view of Lichtenstein U.S. Patent Pub. 2005/0015109 ("Lichtenstein").

According to the MPEP 2143, a *prima facie* case of obviousness can be established only if three criteria have been met. "First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

Applicant respectfully requests withdrawal of the rejection because a *prima facie* case of obviousness cannot be established against the claims. In particular, Lichtenstein fails to cure the disclosure deficiencies of Mazzocchi discussed above. Neither Mazzocchi nor Lichtenstein discloses or suggests an inflatable partitioning element with an interior configured to receive inflation fluid through an inflation port as recited in claim 21, and neither reference discloses or suggests an inflatable partitioning means comprising a hollow interior adapted to contain an inflation fluid and an inflation port communicating with the hollow interior, as recited in claim 33 from which claim 37 depends. Claims 21 and 37 are therefore patentable over Mazzocchi and Lichtenstein under § 103(a).

The Omitted Claims

The Examiner's rejection failed to address pending claims 47-51 and 62-66. These claims are patentable over the prior art of record under both § 102 and § 103.

New Claims 71 and 72

New claims 71 and 72 depend from amended claims 1 and 49, respectively, and are patentable over the prior art of record.

Withdrawn Claims

Claims 8-10, 27-31, 39, 41-45, 55-59, 68 and 69 were withdrawn from consideration pursuant to an election of species requirement. Each of these claims depends from a generic claim.

DEC 12 2006

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Applicant respectfully requests that these claims be allowed along with the allowance of any generic claims from which they depend.

Request for Corrected Inventorship

Applicant requested a corrected filing receipt on June 27, 2006, to delete Hugh R. Sharkey as an inventor. A signed statement from Mr. Sharkey, a new declaration from the remaining inventor and a Consent of Assignee were submitted in support of that request. Applicant respectfully requests that inventorship in this case be corrected by deleting Mr. Sharkey as a named inventor.

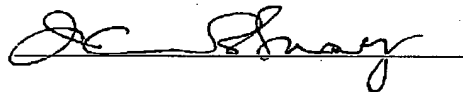
CONCLUSION

For the foregoing reasons, Applicant requests the Examiner allow claims 1-51, 53-69, 71 and 72 and advance the application to issuance.

Respectfully submitted,

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